



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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*09/427,892 10/26/99 WEIFFEN

R 4452-263

EXAMINER

PM82/1018

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ART UNIT

PAPER NUMBER

3613
DATE MAILED:

10/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/427,892

Applicant(s)

WEIFFEN ET AL.

Examiner

Thomas J. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 12 April 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

1. The request filed on September 14, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09427,892 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,971,180 to Kobayashi et al.

Re-claim 1, Kobayashi et al. discloses a vibration damper with a variable damping force, comprising: a working cylinder 12 filled with a damping medium; a piston, see as the combination of piston elements 14 and 92 fastened to a piston rod 16 arranged in an axially movable manner in the working cylinder and dividing the working cylinder into two working spaces 28 and 30; first 36 and second 42 non-return valves are arranged in the piston; a damping valve 90 comprising a valve body 94 and a valve seat defines a flow path 96, the damping valve is arranged in the piston having a variable damping action and is arranged in series with each of the first and second non-return valves, thereby acting in the rebound and compression directions, the damping valve in series with the first and second non-return valves will comprise a sole passage for the damping medium when traveling through the piston between the two working

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spaces such that the damping fluid is required to flow through the flow path 96 of the damping valve when the damping fluid is exchanged between the two working spaces in the rebound and the compression directions of the vibration damper.

Re-claim 2, Kobayashi et al. discloses a damping valve comprises an externally activated actuator for adjusting the variable damping action, see column 5 lines 45-49 and column 6 lines 14-19.

Re-claim 3, the first and second non-return valves are spring loaded valve disks.

Re-claims 4 and 10, the damping valve of Kobayashi et al. is precontrollable to set settings, such as high damping force and low damping force, see column 5 lines 45-49 and column 6 lines 14-19.

Re-claim 5, Kobayashi et al. discloses an electromagnet, or solenoid, as the actuator for the damping valve.

Re-claim 6, the first and second non-return valves are accommodated together in the piston.

Re-claim 8, the first and second non-return valves and the damping valve are arranged in the piston. The examiner is interpreting the piston as the combination of individual piston elements 14 and 92.

Re-claim 9, the first and second non-return valves communicate with the lower working space 28 and the damping valve actuates via the flow connection to the upper working space 30.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al.

The first and second non-return valves are fixedly connected to the piston by element 44. Kobayashi et al. are silent as to if the non-return valves are preassembled as a modular unit. The examiner takes official notice that the non-return valves and associated seats are a modular unit as illustrated by Kobayashi et al. and that it would have been easier to assemble the unit prior to insertion into the working cylinder. It would have been obvious to one of ordinary skill in the art to have preassembled the non-return valve and associated valve seats prior to their insertion into the working chamber, thus easing the assembly of the vibration damper.

Conclusion

7. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is (703) 305-1346. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

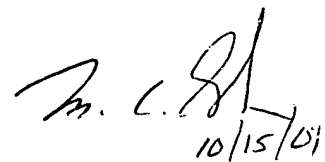
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The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

TJW

October 15, 2001


10/15/01

MATTHEW C. GRAHAM
PRIMARY EXAMINER
GROUP 310